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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,875	11/09/2001	Nicholas A. Thomas	13660.36	4335
21999	7590	07/24/2006	EXAMINER	
KIRTON AND MCCONKIE 60 EAST SOUTH TEMPLE, SUITE 1800 SALT LAKE CITY, UT 84111			LASTRA, DANIEL	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 07/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/035,875		THOMAS ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	DANIEL LASTRA		3622	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 May 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6,8-13,15-17 and 21-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-13,15-17 and 21-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____  | 6) <input type="checkbox"/> Other: _____                                    |

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### **DETAILED ACTION**

1. Claims 1-6, 8-13, 15-17 and 21-29 have been examined. Application 10/035,875 (METHODS AND SYSTEMS FOR ELECTRONIC COUPON ISSUANCE TRANSMISSION AND MANGEMENT) has a filing date 11/09/2001 and Claims Priority from Provisional Application 60247104 (11/10/2000).

#### ***Response to Amendment***

2. In response to Non Final Rejection filed 12/06/2005, the Applicant filed a Request for reconsideration on 05/11/2006.

#### ***Claim Objections***

3. Claim 29 is objected to because it is marked as "(Currently amended)", however, said claim was not amended. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-11 and 13, 15-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Fajkowski (U.S. 5,905,246).

As per claim 1, Fajkowski teaches:

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A system for utilizing an electronic coupon, the system comprising a vendor computer device configured to utilize the electronic coupon to provide a benefit (see column 4, lines 15-64);

a purchaser computer device configured to communicate with the vendor computer device at a point of sale (see column 4, lines 15-64); and

a short-range communications device coupled to the purchaser computer device to enable the communication with the vendor computer device at the point of sale (see column 4, lines 15-64); wherein at least one of (i) the vendor computer device and (ii) the purchaser computer device is configured to manage the electronic coupon (see column 4, lines 15-64).

As per claim 3, Fajkowski teaches:

A system as recited in claim 1, further comprising a secondary computer device configured to transceive the electronic coupon (see column 4, line 63 – column 5, line 38).

As per claim 4, Fajkowski teaches:

A system as recited in claim 1, wherein said secondary computing device is at least one of (i) a server; and (ii) a personal computer (see column 4, line 63 – column 5, line 38).

As per claim 5, Fajkowski teaches:

A system as recited in claim 1, wherein the purchaser computer device comprises at least one of (i) a cell phone; and (ii) a personal digital assistant (see column 6, lines 60-67).

As per claim 6, Fajkowski teaches:

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A system as recited in claim 1, wherein the communications device employs wireless communication (see column 6, lines 60-67).

As per claim 8, Fajkowski teaches:

In a system that includes a purchaser computer device, a vendor computer device, and an electronic coupon, a method for utilizing the electronic coupon, the method comprising the steps for:

providing the electronic coupon (see column 4, lines 15-64);

determining the validity of using the electronic coupon (see column 4, lines 14-64; col 17, lines 1-21);

if the electronic coupon is determined to be valid for use, providing a benefit to a user (see column 4, lines 14-64; col 17, lines 1-65);

determining the validity of using a second electronic coupon; comparing the electronic coupon with the second electronic coupon to determine which electronic coupon is preferred, wherein the benefit provided to the user corresponds to the preferred electronic coupon (see column 17, lines 1-21; col 19, lines 39-67).

As per claim 9, Fajkowski teaches:

A method as recited in claim 8, wherein the electronic coupon is provided from the purchaser computer device to the vendor computer device (see column 4, lines 14-64).

As per claim 10, Fajkowski teaches:

A method as recited in claim 9, wherein the step for providing comprises at least one of the steps for:

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- (i) scanning the electronic coupon (see column 3, lines 50-67);
- (ii) transmitting the electronic coupon via a wireless communication connection (see column 4, lines 6, lines 60-67); and
- (iii) transmitting the electronic coupon via a hard-wired communication connection (see column 6, lines 20-30).

As per claim 11, Fajkowski teaches:

A method as recited in claim 8, wherein the step for determining comprises the step for verifying the identity of the user (see column 4, lines 1-8).

As per claim 13, Fajkowski teaches:

A method as recited in claim 8, wherein the electronic coupon is provided from a secondary computer device (see column 5, lines 15-64).

As per claim 15, Fajkowski teaches:

A method as recited in claim 14, wherein the step for comparing includes at least one of the steps for:

- (i) examining an expiration date (see column 19, lines 50-67); and
- (ii) determining which provides a greater benefit (see column 19, lines 50-67).

As per claim 16, Fajkowski teaches:

A method as recited in claim 15, wherein the greater benefit is determined based on at least one of:

- (i) promptness in redemption;
- (ii) frequency of purchase;
- (iii) type of payment employed;

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(iv) one or more products presented for purchase;

(v) one or more manufacturers of products presented for purchase;

and

(vi) one or more vendors of products presented for purchase (see column 19, lines 15-67).

As per claim 17, Fajkowski teaches:

In a system that includes a first electronic coupon, a first computer device that provides the first electronic coupon, and a second computer device that receives the first electronic coupon, a method for distributing the first electronic coupon, the method comprising the steps for:

providing the first electronic coupon at the first computer device (see column 4, lines 15-64), wherein the step for providing the first electronic coupon comprises the steps for populating a database on a server with a plurality of downloadable electronic coupons, wherein the first electronic coupon is one of the plurality of downloadable electronic coupons (see column 5, lines 15-65).;

selectively transmitting the first electronic coupon from the first computer device to the second computer device to enable a benefit to be provided to a user of the second computer device (see column 4, lines 15-64); wherein the step for selectively transmitting comprises the steps for:

providing access to the database (see column 6, lines 20-30);

receiving a request for downloading the first coupon from the data base (see column 6, lines 20-30); and downloading the first electronic coupon to in

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response to the request (see column 6, lines 20-30), wherein the request is initiated automatically based on preset criteria (see column 6, lines 60-67).

As per claim 21, Fajkowski teaches:

A method as recited in claim 19, wherein the request is selectively initiated by at least one of

- (i) the user (see column 6, lines 60-67);
- (ii) a vendor;
- (iii) a manufacturer of a product; and
- (iv) a provider of a service.

As per claim 22, Fajkowski teaches:

A method as recited in claim 19, wherein the step for downloading is performed across the Internet (see column 6, lines 20-30).

As per claim 23, Fajkowski teaches:

A method as recited in claim 17, wherein the step for selectively transmitting is performed across a wireless communication (see column 6, lines 60-67).

As per claim 24, Fajkowski teaches:

A method as recited in claim 17, wherein the first electronic coupon is an electronic data file stored locally on the second computer device (see column 6, lines 60-67).

As per claim 25, Fajkowski teaches:

A method as recited in claim 17, wherein the first electronic coupon is an electronic reference location on a network that references the first computer



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device to a location where the electronic coupon is stored (see column 6, lines 20-30).

As per claim 26, Fajkowski teaches:

A computer program product for implementing within a computer system a method for utilizing an electronic coupon, the computer program product comprising: computer readable medium for providing computer program code means utilized to implement the method, wherein the computer program code means is comprised of executable code for implementing the steps for:

providing the electronic coupon (see column 4, lines 15-64);

determining the validity of using the electronic coupon (see column 4, lines 15-64; col 17, lines 1-22);

if the electronic coupon is determined to be valid for use, providing a benefit to a user (see column 4, lines 15-64); determining the validity of using a second electronic coupon; and comparing the electronic coupon with the second electronic coupon to determine which electronic coupon is preferred, wherein the benefit provided to the user corresponds to the preferred electronic coupon (see column 17, lines 1-65; col 19, lines 39-67).

As per claim 27, Fajkowski teaches:

The computer program product as recited in claim 26, further comprising computer program code means comprised of executable code for implementing the step for tracking information (see column 5, lines 15-64).

As per claim 28, Fajkowski teaches:

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The computer program product as recited in claim 26, further comprising computer program code means comprised of executable code for implementing the step for providing a notification relating to the electronic coupon (see column 24, lines 20-55).

As per claim 29, Fajkowski teaches:

A computer program product for implementing within a computer system a method for distributing the electronic coupon, the computer program product comprising: computer readable medium for providing computer program code means utilized to implement the method, wherein the computer program code means is comprised of executable code for implementing the steps for:

providing the electronic coupon at a first computer device (see column 4, lines 15-64);

selectively transmitting the electronic coupon from the first computer device to a second computer device to enable a benefit to be provided to a user of the second computer device (see column 4, lines 15-64); determining the validity of using a second electronic coupon and comparing the electronic coupon with the second electronic coupon to determine which electronic coupon is preferred, wherein the benefit provided to the user corresponds to the preferred electronic coupon (see column 17, lines 1-65; col 19, lines 39-67).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fajkowski (US 5,905,246) in view of Kepecs (US 6,330,543).

As per claims 2 and 12, Fajkowski teaches:

A system as recited in claim 1, but fails to teach further comprising a biometric input device coupled to the purchaser computer device for positive identification of a user. However, Kepecs teaches a system that uses biometric identification for positive identification of a user (see column 12, lines 5-15). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Fajkowski would use the Kepecs's biometric identification system to allow the provider of the coupon card services to identify each individual to whom a coupon card is registered. Biometric identification would replace the use of identification numbers to positive identify users.

### ***Response to Arguments***

6. Applicant's arguments filed 05/11/2006 have been fully considered but they are not persuasive. With respect to the 112 rejection, although the limitation was found in claim 14 of the Application as originally filed, said limitation was not described in the Specification, therefore, leaving to the Examiner the interpretation of said limitation.

The Applicant argues that Fajkowski does not teach a purchaser computer device that is configured to manage the electronic coupons but rather a coupon card that can be used to store multiple coupons. The Examiner answers that Applicant's definition of a purchaser computer device is simply a computer device that stores and manipulates electronic coupons<sup>1</sup>. Fajkowski teaches a computer device that stores and manipulates electronic coupons<sup>2</sup>, therefore, Fajkowski teaches Applicant's purchaser computer device as defined by Applicant's specification.

The Applicant argues that Fajkowski does not teach determining the validity of using a second electronic coupon and comparing the electronic coupon with the second electronic coupon to determine which electronic coupon is preferred, wherein the benefit provided to the user corresponds to the preferred electronic coupon. The Examiner answers that said limitation is not described in Applicant's specification, therefore, leaving the Examiner the interpretation of said limitation. Fajkowski teaches a system that after an analysis of various coupons determines to redeem a technically non-redeemable coupon<sup>3</sup> and also compares the validity of one or more coupon that are valid to a purchased item, prompting the customer to select the coupon said customer wishes to redeem<sup>4</sup>. Therefore, Fajkowski system compares various coupons, which are valid for a purchased item and allows a customer to select the coupon, which would

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<sup>1</sup> Applicant's specification page 9, lines 9-12

<sup>2</sup> Fajkowski figure 4a; col 3, line 50 – col 4, line 63

<sup>3</sup> Fajkowski column 19, lines 50-67

<sup>4</sup> Fajkowski col 17, lines 1-22

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provide the greatest benefit to said customer, similar to the Applicant's claimed invention.

The Applicant argues with respect to claim 17 that Fajkowski only discloses pre-selecting coupons and does not disclose preset criteria used in selecting coupons as disclosed in a non-limiting example, the invention may utilize preset parameters that increase the likelihood that a user would use a particular coupon in order to determine which coupon to send a particular consumer. The Examiner answers that the Applicant's specification page 27, lines 1-5 do not recite the term "preset criteria" and "in order to determine which coupon to send a particular consumer". Applicant's specification page 27, lines 1-5 recites "The coupons may be obtained as they are made available or may be obtained according to preset parameters that increase the likelihood that the user would use the coupons. The electronic coupon service allows the user to view the list of available coupons and selectively or automatically download electronic coupons to the HCD". Fajkowski teaches a system which allows users to obtain coupons based upon preselected parameters such as preselecting a group coupons<sup>5</sup>, therefore, Fajkowski teaches Applicant's claimed limitation.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is

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<sup>5</sup> Fajkowski col 6, lines 60-67

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filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

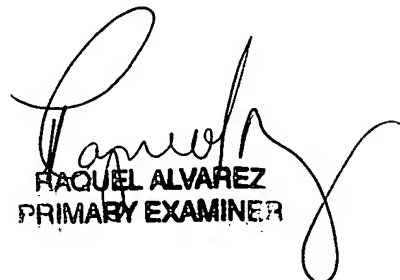
Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Daniel Lastra

July 12, 2006

  
RAQUEL ALVAREZ  
PRIMARY EXAMINER